



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/542,149 06/22/90 KEITH

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EXAMINER

MIGALSKY, G

ART UNIT

PAPER NUMBER

1814

DATE MAILED:

01/14/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined

☒ Responsive to communication filed on 10/5/92
12/2/92

☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 11-22 are pending in the application.

Of the above, claims 17-22 are withdrawn from consideration.

2. ☒ Claims 1-10 have been cancelled.

3. ☐ Claims are allowed.

4. ☒ Claims 11-16 are rejected.

5. ☐ Claims are objected to.

6. ☐ Claims are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

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The amendment of 5th October 1992 is acknowledged. Claims 1-10 have been cancelled and new claims 11-22 have been submitted. Claims 17-22 have been withdrawn from consideration as they are belong to non-elected Group II.

5 The petition to correct the inventorship of this application under 37 C.F.R. § 1.48(a) is deficient because the statement of facts by the originally named inventor is insufficient. It is noted that Dr. Keith signed not only the original declaration, but also filed a declaration under 37 C.F.R. 1.131 on December
10 19, 1991, with submitted laboratory data that was used to overcome a 102(a) rejection. In this declaration he again asserted that he was the inventor. It is now unclear who generated the submitted laboratory data. Is the submitted laboratory data the work of Dr. Keith or Dr. Cieplak (the
15 proposed new inventor)? The Examiner deems that the error in inventorship appears to have been inadvertent, but in view of the declaration under 37 C.F.R. 1.131 does not believe an adequate explanation of the facts has been presented. Applicant is reminded that the grant of the petition to correct inventorship
20 will result in the loss of inventorship overlap between the parent applications and the continuing application and an ability to claim benefit in the continuing application of the parent applications' filing dates under 35 U.S.C. §120. Intervening references must then be considered. Applicant is also reminded

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that any previously entered declarations would not be considered valid in future prosecution upon the grant of the petition to correct inventorship.

5 The Examiner thanks the Applicant's representative for pointing out the negative control for ribosylating activity was about 800 cpm. Thus, the objections to the term "substantially reduced" which were raised in the previous Action are overcome.

10 The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

(f) he did not himself invent the subject matter sought to be patented.

15 Claims 11-16 are rejected under 35 U.S.C. § 102(f) because the applicant did not invent the claimed subject matter. This rejection is made based on the unresolved issue of the requested change in inventorship, and will be withdrawn upon submission of an adequate explanation of the facts.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20 Pizza et al. produce site directed mutations in the B. pertussis S1 subunit. The declaration filed under 37 C.F.R. 1.131 precludes use of this reference as prior art.

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The U.S. filing date of the Klein patent (No. 5,085,562) was 11/23/88. The declaration filed under 37 C.F.R. 1.131 precluded use of this reference as prior art in the previous Action.

5 Declaration of an interference is premature prior to resolution of all issues raised during prosecution.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriele E. Bugaisky, Ph.D. whose telephone number is (703) 308-4201.

10 Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM-1 Fax
15 Center number is (703) 308-4227.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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January 8, 1993

Robert A. Wax
ROBERT A. WAX
SUPERVISORY PATENT EXAMINER
GROUP 180